

Serial No. 10/657,524

Amdt. in Response to Office Action mailed July 1, 2008

UTILITY PATENT

B&D No. TN3481

REMARKS

Applicant has amended Claim 1.

Currently pending in the application are Claims 1-9 and 17-18.

The Examiner objected to Claim 18 because of an inaccurate status identifier. In response, Applicant has corrected the status identifier in the present amendment.

The Examiner rejected Claims 1, 6-9 and 17-18 under 35 USC § 112, second paragraph, as being indefinite. In particular, the Examiner has objected to the use of the parenthetical clauses. In response, Applicant has deleted the second parenthetical clause. As to the first parenthetical clause, Applicant believes that such clause is part of the claimed invention, as the clause defines how to determine the forwardmost edge of the blade called for in Claim 1, i.e., it is the forwardmost edge along a horizontal direction extending from the auxiliary fence.

The Examiner found that the phrase "first forwardmost edge of the blade" was unclear as to what structure was being claimed. In response, Applicant has amended Claim 1 to remove such indefiniteness. Claim 1 now provides that the claimed blade edge is the forwardmost edge along a horizontal direction extending from the auxiliary fence. This is shown in FIG. 4 as the edge of blade 19 above point 19P.

As to phrase "second forwardmost edge of the blade," Applicant has amended Claim 1 to remove such indefiniteness. Claim 1 now provides that the claimed blade edge is the forwardmost edge along a horizontal direction extending from the fixed fence. This is shown in FIG. 4 as the edge of blade 19 below point 19P.

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The Examiner rejected Claims 1, 6-9 and 18 under 35 USC 102(b) as anticipated by EP 0 752 300 ("EP '300"). In addition, the Examiner rejected Claim 17 under 35 USC § 103(a) as being unpatentable over EP '300. Reconsideration and withdrawal of these rejections are respectfully requested.

The Examiner has argued that the claimed auxiliary fence is the "upper, reduced cross-section portion of component 40." However, it is unclear whether the Examiner refers to the portion disposed below reference numeral "32" in FIG. 4 of EP '300 or to the portion to the left of such numeral. In the last Amendment, Applicant discussed both possibilities. In response to the last Amendment, the Examiner did not specify which interpretation was meant by the Examiner, and stated that "any and all interpretations should be considered."¹

Referring to the attached Exhibit A, the top drawing shows a substantially rectangular workpiece placed against the portion disposed below reference numeral "32" in FIG. 4 of EP '300. Similarly, the bottom drawing shows a substantially rectangular workpiece disposed against the portion to the left of reference numeral "32" in FIG. 4 of EP '300. As shown in both figures, the blade 18 is moved to its rearmost position. Accordingly, blade 18 will not fully cut the workpiece in between the component 40 and blade 18. Such uncut portions are shown in dashes.

By contradistinction, Claim 1 requires that "the blade fully cut[] a substantially rectangular workpiece placed against the auxiliary fence and completely disposed within a first distance between the auxiliary fence and a first forwardmost edge of the blade." Because the

¹ Applicant submits that the Examiner should specify which interpretation is correct so that the prosecution history is clear. If there are other interpretations that have not been considered, Applicant requests that the Examiner specify such interpretations so that Applicant can fully respond to the Examiner's comments.

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arrangement of EP '300 does not provide for such cutting capacity, EP '300 cannot anticipate or render unpatentable Claim 1 and its dependent claims.

The Examiner replied that similar past arguments were not persuasive because of three reasons. First, it is not clear what structure is being claimed. Applicant has removed such indefiniteness, as discussed in the response to the § 112 rejection above.

Second, the Examiner alleges that "applicant is attempting to positively define the invention in terms of the workpiece, wherein the workpiece is not part of the claimed invention." While the workpiece is not part of the claimed invention, Applicant is using the interaction with a particular workpiece to describe a particular structure.

This is allowed under the law. Indeed, MPEP § 2173.01 states that applicants "can define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification" and "use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought." Accordingly, the manner in which the subject matter is being claimed is proper.

Finally, the last objection was that Applicant was "interpreting the claim as requiring the workpiece to extend from the auxiliary fence to at least one of the forwardmost edges of the blade," while "the claim only requires that the workpiece is disposed within the claimed boundaries." The Examiner is correct. Applicant has now amended the claim so that the workpiece has to be placed against the fence.

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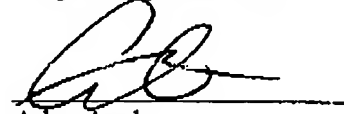
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In view of the foregoing, Claims 1-9 and 17-18 are patentable and the application is believed to be in condition for formal allowance.

No fee is believed due. Nonetheless, the Commissioner is authorized to charge payment of any fees due in processing this amendment, or credit any overpayment to Deposit Account No. 02-2548.

Respectfully submitted,



Adan Ayala

PTO Reg. No. 38,373

Attorney for Applicant

Adan Ayala - TW-199
The Black & Decker Corporation
701 East Joppa Road
Towson, Maryland 21286
(410) 716-2368